

Remarks

In the official action the Examiner rejects claims 1, 2, 11, 12, 16-18, 36-40, 45, 46, 51, 54, 55, 58, 63 and 65-68 under 35 U.S.C. 102 as being fully anticipated by the Applicant's prior US Patent No. 5,046,824 to Pepper.

Turning first to claim 1, claim 1 has been amended to include certain limitations heretofore in claims 6 and 7.

It is believed, with these amendments, that claim 1 clearly differentiates itself from Pepper. Claim 1, as amended, recites, *inter alia*, that the "first wavefront error sensor sensing a distortion of the first beam, computing a correction, and addressing the first adaptive optical wave front corrector to reduce the distortion of the first beam by producing the corrected first beam after reflection of the first beam by the first adaptive optical wavefront corrector..." It is believed that Pepper does not show that feature.

The next independent claim in the application is claim 11. It too was rejected based upon Pepper. This grounds for rejection is not understood.

It is noted that claim 11 is different than claim 1, but in the rejection of claim 11, the Examiner only seems to address the limitations of claim 1. Why is claim 11 being rejected when the rationale given for rejecting the claim is based upon claim 1? With all due respect to the Examiner, that does not make sense.

Moreover, it is noted that this rejection does not comply with the Rules of Practice that require, that when the Examiner is rejecting a claim based upon a reference that is complex or shows or describes inventions other than that claimed by the Applicant, that "the particular part relied upon must be designated as nearly as practicable." See 37 CFR 1.104(c)(2).

Consider claim 11, for example, that recites, among other things, "correcting propagation distortions of the first and second optical beams." Just which beams in

Pepper does the Examiner consider to be the first and second optical beams and, moreover, where would correction of propagation distortions of those beams occur in Pepper? Presumably, when the Examiner makes the rejection, the Examiner knows what he has in mind in terms of reading such a limitation on Pepper, but if that information is not communicated in the official action, then it makes it very difficult for the Applicant to try to respond to the rejection. As things presently stand, the Applicant does not understand how the Examiner is reading claim 11 upon Pepper, and therefore this grounds for rejection is respectfully traversed.

Turning to claim 16, claim 16 has been amended to move the essence of a limitation from claim 17 into claim 16. With respect to the Examiner's rejection of claim 17, that rejection is not understood. Where does Pepper allegedly show that propagation errors (or distortion) are corrected by a first and second adaptive optical modules as originally recited in claim 17?

In the future, should the Examiner reject any claims in this application, it would be very helpful if the Examiner would point out, with specificity, where each and every limitation of each and every rejected claim is allegedly shown or suggested by the prior art.

Turning to the next independent claim in the application, claim 37, the Examiner rejected that claim as also being allegedly anticipated by Pepper. This grounds for rejection is respectfully traversed. It is noted, that in rejecting claim 37, the Examiner does not discuss any of the steps involved in the claim, but rather rejects claim 37 due to the subject matter of claim 1. Since claim 37 is a method claim and claim 1 is an apparatus claim, and given the fact that they read differently, they are obviously of different scope. If the Examiner comes up with a rationale for rejecting claim 1, it does not mean that that rationale automatically applies to all of the other independent claims in the application, even if they are of a shorter length than claim 1. Each claim needs to be treated on its own merits and, as things presently stand, the Applicant does not understand why claim 37 has been rejected based upon Applicant's prior US Patent. For example, where does Pepper teach "detecting the propagation errors by the at least one

adaptive optical module” “computing a correction to compensate for the propagation errors” and “applying the correction to the received optical beam”?

Independent claim 45 has been amended. Claim 45, as presented, appears to have been inadvertently presented incomplete since it ended with a semicolon. It has now been amended to include a recitation of “correcting propagation errors in the first and second optical beams.” That same limitation can be found in original claim 11 and serves to differentiate the claim from Pepper.

Turning now to claim 54, that claim was also rejected as being fully anticipated by Pepper. This grounds for rejection is respectfully traversed. Claim 54 has been amended, but only to replace the semicolon at the end of the claim with a period. As such, the scope of claim 54 is not affected in any way by this amendment.

When rejecting claim 54 based upon Pepper, the Examiner used the same analysis that the Examiner used with respect to claim 1. However, claim 54 is different than claim 1. Note the recitation of a first wavefront error sensor adjacent the first region and a second wavefront sensor disposed adjacent the second region.

Presumably, when the Examiner made this rejection, the Examiner knew just what elements of Pepper that the Examiner was reading the first and second wavefront error sensors upon and, moreover, where the first and second regions of the adaptive optical wavefront corrector are located in Pepper. However, since the Examiner did not communicate that information in the official action as the Examiner is obligated to do under the Rules of Practice, the Applicant is at a bit of a loss to respond to this rejection.

As noted above, it is the Examiner’s obligation to point out these matters in official actions.

Reconsideration of this application as amended is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents

POB 1450, Alexandria, VA 22313-1450 on

August 20, 2004

(Date of Deposit)

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